

REMARKS

Claims 1-46 and 51-72 are pending in this application. Claims 37, 38, 41-45, 51-59 and 66-72 have been withdrawn from consideration as being directed to a non-elected invention. Claim 46 has been allowed, claims 6-14, 17, 19-35, 61, 62, 64 and 65 were deemed to present allowable subject matter, and were only objected to as being dependent upon rejected base claims, and claims 1-5, 15, 16, 18, 36, 39, 40, 60 and 63 have been rejected. Claims 1, 36, 39, 41 (withdrawn), 46 (allowed), 51 (withdrawn), 57 (withdrawn), 60, 66 (withdrawn) and 72 (withdrawn) were independent.

This Amendment cancels claim 6 (its features have been incorporated into claim 1) and revises claims 1, 7, 8, 11, 12, 32, 36, 39, 60, 61 and 64 (the changes to claims 7, 8, 11, 13, 32 and 33 alter the dependencies of those claims due to the cancellation of claim 6). Claims 1, 36, 39, 41 (withdrawn), 46 (allowed), 51 (withdrawn), 57 (withdrawn), 60, 61, 64, 66 (withdrawn) and 72 (withdrawn) are now independent.

The Examiner is thanked for the allowance of claim 46. Claim 46 has been maintained unchanged, and so is believed to remain allowable.

The Examiner also is thanked for the indicated allowability of claims 6-14, 17, 19-35, 61, 62, 64 and 65. The subject matter of claim 6 has been transferred to independent claim 1, and claims 61 and 64 have been placed into independent form, and so claims 1, 61 and 64 are believed to be allowable. The rest of these claims all ultimately depend from claims 1, 61 or 64, meaning those claims are likewise in condition for allowance.

Requested Cancellation of Various Withdrawn Claims

The Office Action requested the cancellation of claims 37, 38, 41-45, 51-59 and 66-72, which were withdrawn from consideration as being directed to a non-elected species of invention.

Applicants respectfully decline to cancel these claims, because, as explained at page 25 of the Amendment filed on May 14, 2007, this application contains an allowed generic claim (claim 46), and the consideration of additional species was previously requested, and is again requested herein.

**The Rejection Under
35 U.S.C. § 103**

Claims 1-5, 15, 16, 18, 36, 39, 40, 60 and 63 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 4,604,633 to Kimura et al. in view of U.S. patent no. 6,243,115 to Baker et al. Applicants respectfully traverse this rejection, and submit the following arguments in support thereof.

Claim 1 has been revised to include the features of allowable claim 6; claim 1 now provides for a liquid container containing liquid to be supplied to a liquid consuming apparatus. This container has a container body, a first reservoir chamber located within the container body and which is at least in part defined by a first flexible member, a second reservoir chamber located within the container body and which is at least in part defined by a second flexible member, an urging member which urges the second flexible member in a direction from a first position to a second position, a liquid delivery port formed in the container body, and a first flow path through which the first reservoir chamber is in fluid communication with the second reservoir chamber. Also, there is a second flow path through which the second reservoir chamber is in fluid communication with the liquid delivery port. The second reservoir chamber

expands to cause the second flexible member to reach the first position when pressure is applied through the first flexible member to the liquid existing a predetermined amount or more in the first reservoir chamber.

Claim 36 describes a liquid container for storing liquid to be supplied to a liquid consuming apparatus, which is constructed such that pressurized fluid is sent to its inside so that the liquid in the inside is delivered to the outside, and the liquid container includes a container body, a first reservoir chamber which stores the liquid within and which is provided in the container body, a second reservoir chamber to which the liquid is supplied from the first reservoir chamber and which is provided in the container body, a pressurized fluid introduction port for introducing the pressurized fluid to the inside of the container body, a detection unit which is attached to the second reservoir chamber and outputs an output signal which indicates whether an amount of the liquid stored in the first reservoir chamber is more than a predetermined value, and a pressurizing unit which pressurizes the liquid in the second reservoir chamber.

As provided for in claim 39, this invention also involves a liquid container constructed such that a pressure is applied to liquid in a liquid containing chamber by a pressure of a pressurized fluid fed from a pressurized fluid introduction port to feed the liquid to a liquid consuming apparatus from a liquid delivery port, liquid in a liquid containing chamber is selectively pressurized from outside to feed the liquid in the liquid containing chamber to the liquid consuming apparatus from the liquid delivery port, or liquid in a liquid containing chamber is constantly pressurized by a built-in pressurizing unit to feed the liquid to the liquid consuming apparatus from the liquid delivery port. The liquid container has a buffer chamber connected to a channel for connecting the liquid containing chamber to the liquid delivery port,

and the buffer chamber is expanded in its volume by an inflow of the liquid from the liquid containing chamber to the buffer chamber, and contracted when the inflow of the liquid from the liquid containing chamber to the buffer chamber is stopped. A detecting unit is adapted to output a signal in relation to a volume variation of the buffer chamber, and a pressurizing unit pressurizes the liquid in the buffer chamber.

According to claim 60, this invention involves a liquid container for storing liquid to be supplied to a liquid consuming apparatus, which is constructed such that pressurized fluid is introduced into its inside so that the liquid in the inside is pressurized and is delivered to the outside. The liquid container includes a container body having a pressurized fluid introduction port for introducing the pressurized fluid into the inside and a liquid delivery port for delivering the liquid to the outside, a first liquid reservoir chamber which is formed in the inside of the container body, stores the liquid, and is constructed such that its volume is decreased by receiving pressure of the pressurized fluid, and a second liquid reservoir chamber which is formed in the inside of the container body and communicates with the first liquid reservoir chamber and in which the pressure of the pressurized fluid applied to the liquid in the inside of the first liquid reservoir chamber is transmitted through the liquid to the liquid in the inside of the second liquid reservoir chamber and its volume is changed in accordance with pressure of the liquid in the inside changed by transmission of the pressure of the pressurized fluid. A narrow flow path is formed at a midway of a liquid flow path communicating the first liquid reservoir chamber and the liquid delivery port, and is openably closed by a movable part displaced in accordance with the change of the volume of the second liquid reservoir chamber in a state where the liquid in the first liquid reservoir chamber is not pressurized by the pressurized fluid.

Since claim 1 incorporates the features of allowable claim 6 (now cancelled), claim 1 patentably distinguishes over the cited art for the same reasons.

With regard to the remaining rejected independent claims it is noted that the Office Action only discusses the subject matter claims 1-3 and 18; the Office Action lacks any explanation of how the cited art is applied to the other rejected independent claims, claims 36, 39 and 60. The Office Action therefore fails to comply with M.P.E.P. § 706.02(j) ("Contents of a 35 U.S.C. 103 Rejection"), which states in part that "[a]fter indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: . . . (B) the difference or differences in the claim over the applied reference(s)".

Since the Office Action does not discuss claims 36, 39 and 60, or the remaining rejected dependent claims, the Office Action fails to make the required Graham findings regarding the differences between the claimed invention and the prior art that the Patent and Trademark Office requires. This obligation is set forth most recently by the Patent and Trademark Office in its Federal Register Notice entitled "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", 72 Fed. Reg. 57526 (October 10, 2007).¹

¹ The Federal Register Notice, discussing the factual findings which Graham v. Deere, 383 U.S. 1 (1966), requires an Examiner to make, provides in pertinent part:

The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) **Ascertaining the differences between the claimed invention and the prior art;** and
- (3) Resolving the level of ordinary skill in the pertinent art.

* * * *

Office personnel fulfill the critical role of factfinder when resolving the Graham inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying Graham inquiries are factual. **When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.** In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made

Since the Office Action does not mention the features of claims 4, 5, 15, 16, 36, 39, 40, 60 and/or 63, or explain why any of those features are suggested by the cited art, the Office Action therefore fails to comply with M.P.E.P. § 706.02(j) and the Patent and Trademark's Office's October 10 Notice regarding KSR. Consequently, the Office Action fails to establish a *prima facie* case of unpatentability for those claims.

Turning to the cited references, Applicants have the following specific comments as to why the claimed invention patentably distinguishes over those references.

With regard to claims 36 and 39, neither Kimura nor Baker, or the combination, suggests at least the aspects of the claimed invention involving the pressurizing unit which pressurizes liquid in the second reservoir chamber. In fact, the Office Action, at page 4, states in part that such a feature, as recited in claim 46, **distinguishes over the prior art**.

Turning to claim 60, Kimura and Baker together do not suggest at least the aspects of the claimed invention involving the narrow flow path that is formed at the midway of the liquid flow path communicating the first liquid reservoir chamber and the liquid delivery port, and which is openably closed by a movable part displaced in accordance with the change of the volume of the second liquid reservoir chamber in a state where the liquid in the first liquid reservoir chamber is not pressurized by the pressurized fluid.

Claims 2-5, 15, 16, 18, 40 and 63 all ultimately depend from independent claims that have just been shown to patentably distinguish over the cited art. Accordingly, these claims are patentable over the cited art at least for the same reasons as their respective base claims, which reasons are incorporated by reference herein.

by Office personnel are the necessary underpinnings to establish obviousness.
72 Fed. Reg. 57527 (emphasis added)

For all the foregoing reasons, favorable reconsideration and withdrawal of this rejection are respectfully requested.

Miscellaneous

The Office Action, referring to Applicants' arguments in the Amendment filed on May 14, 2007, distinguishing the claimed invention from cited U.S. patent no. 6,322,205 to Childers et al., states at page 4, "[t]he applicant's arguments over Childers are moot without traverse.

It is not understood what the Office Action means by "moot without traverse". Clearly, Applicants' prior arguments regarding Childers were sufficiently persuasive to cause the Examiner to conduct a new search of the prior art and identify new references to apply. This follows from the statement in the Office Action at page 2 "[t]he new prior art reference necessitated a new ground of rejection as shown below." Because the only new reference applied in the Office Action is Kimura, which was cited by the Examiner, the only possible conclusion is that the Examiner, having considered Applicants' remarks regarding Childers, deemed it necessary to conduct an additional search for prior art, during which Kimura was found.

Thus, it is understood that Applicants' earlier arguments distinguishing Childers were persuasive.

CONCLUSION

Favorable consideration and prompt allowance of this application are respectfully requested.

Other than the additional claim fees authorized in the accompanying Fee Transmittal form, no fees are believed to be due in connection with the filing of this paper. If, however, any fees are deemed to be now or hereafter due in connection with this application, the Commissioner is authorized to charge all such fees to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

Respectfully submitted,

/David L. Schaeffer/

David L. Schaeffer
Reg. No. 32,716
Attorney for Applicants
Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, New York 10038-4982
Tel: (212) 806-6677